



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/786,024	07/05/2001	Long Yu	A34054 PCTUSA	3983

21003 7590 09/10/2002

BAKER & BOTT'S
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

FRONDA, CHRISTIAN L

ART UNIT PAPER NUMBER

1652

DATE MAILED: 09/10/2002

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/786,024	Applicant(s) Yu et al.
	Examiner Christian L. Fronda	Art Unit 1652
-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --		
Period for Reply		
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.		
<ul style="list-style-type: none"> - Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). 		
Status		
1) <input type="checkbox"/> Responsive to communication(s) filed on _____.		
2a) <input checked="" type="checkbox"/> This action is FINAL . 2b) <input type="checkbox"/> This action is non-final.		
3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11; 453 O.G. 213.		
Disposition of Claims		
4) <input checked="" type="checkbox"/> Claim(s) <u>1, 3, 6-11, and 15</u> is/are pending in the application.		
4a) Of the above, claim(s) _____ is/are withdrawn from consideration.		
5) <input checked="" type="checkbox"/> Claim(s) <u>3 and 15</u> is/are allowed.		
6) <input checked="" type="checkbox"/> Claim(s) <u>1 and 6-10</u> is/are rejected.		
7) <input checked="" type="checkbox"/> Claim(s) <u>11</u> is/are objected to.		
8) <input type="checkbox"/> Claims _____ are subject to restriction and/or election requirement.		
Application Papers		
9) <input type="checkbox"/> The specification is objected to by the Examiner.		
10) <input type="checkbox"/> The drawing(s) filed on _____ is/are a) <input type="checkbox"/> accepted or b) <input type="checkbox"/> objected to by the Examiner. <p style="margin-left: 20px;">Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).</p>		
11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved by the Examiner. <p style="margin-left: 20px;">If approved, corrected drawings are required in reply to this Office action.</p>		
12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.		
Priority under 35 U.S.C. §§ 119 and 120		
13) <input checked="" type="checkbox"/> Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). <p style="margin-left: 20px;">a) <input checked="" type="checkbox"/> All b) <input type="checkbox"/> Some* c) <input type="checkbox"/> None of:</p>		
<p style="margin-left: 40px;">1. <input checked="" type="checkbox"/> Certified copies of the priority documents have been received.</p>		
<p style="margin-left: 40px;">2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____.</p>		
<p style="margin-left: 40px;">3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</p>		
<p style="margin-left: 20px;">*See the attached detailed Office action for a list of the certified copies not received.</p>		
14) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e). <p style="margin-left: 20px;">a) <input type="checkbox"/> The translation of the foreign language provisional application has been received.</p>		
15) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.		
Attachment(s)		
1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)		
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)		
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____		
4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____		
5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)		
6) <input type="checkbox"/> Other: _____		

Art Unit: 1652

DETAILED ACTION

1. Claims 1, 3, 6-11, and 15 are under consideration in this Office Action.

Claim Rejections - 35 U.S.C. § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Hillier et al.

Claim 1 is anticipated by Hillier et al. (Accession AA398583) since Hillier et al. teach a nucleotide sequence which encodes a protein that has amino acids 19-146 of SEQ ID NO: 4 and inherently has lysozyme activity (see enclosed alignment).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guan et al.

Art Unit: 1652

(US Patent 5,643,758) in view of Hillier et al. (Accession AA398583).

Guan et al. (US Patent 5,643,758) teach expression vectors, prokaryotic and eukaryotic host cells such as *E. coli*, and methods for making, expressing, isolating, and purifying any protein fused to the *E. coli* maltose binding protein (MBP) and that these methods and products are useful for purifying virtually any hybrid polypeptide molecule employing recombinant techniques (see entire publication). Guan et al. teach that in order to express, isolated, and purify a desired protein, the polynucleotide coding for the desired protein is required for cloning into the expression vectors which is then used in the method for expressing, isolating, and purifying the desired protein (see entire patent and **EXAMPLES I and II**). Guan et al. teach the successful expression, isolation, and purification of beta-galactosidase (**EXAMPLE I**) and PstI restriction endonuclease (**EXAMPLE II**). Guan et al. does not teach a vector containing an DNA molecule encoding a protein comprising the amino acid sequence of amino acids 19-146 of SEQ ID NO: 4 wherein the protein has lysozyme activity and a host cell transformed with said vector wherein the host cell is *E. coli* or a eukaryotic cell.

The teachings of Hillier et al. (Accession AA398583) have been stated above.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to insert the nucleotide sequence taught by Hillier et al. (Accession AA398583) into the expression vector taught by Guan et al. (US Patent 5,643,758) and transform the vector into a host cell such as *E. coli* or a eukaryotic cell as taught by Guan et al. One of ordinary skill in the art at the time the invention was made would have been motivated to do this in order to express, isolate, and purify the protein encoded by the nucleic acid taught by Hillier et al. wherein the protein has lysozyme activity. One of ordinary skill in the art at the time the invention was made would have had a reasonable expectation for success because the methods and products taught by Guan et al. are useful for purifying virtually any hybrid polypeptide molecule employing recombinant techniques and Guan et al. teach the successful expression, isolation, and purification of beta-galactosidase (**EXAMPLE I**) and PstI restriction endonuclease (**EXAMPLE II**). Thus, the claimed invention was within the ordinary skill in the art to make and use at the time was made, and was as a whole clearly *prima facie* obvious.

Claim Objections

6. Claim 11 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Art Unit: 1652

Conclusion

7. Claims 3 and 15 are allowed.

8. Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christian L. Fronda whose telephone number is (703)305-1252. The Examiner can be contacted Monday-Friday from 8:30AM - 5:00PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, can be reached at (703)308-3804. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is (703)308-0196.

CLF


NASHAAT T. NASHED PHD.
PRIMARY EXAMINER